

REMARKS

In the Office Action, the Examiner rejected claims 13-27 under 35 USC § 112, first paragraph. Claims 1-10 and 32 were rejected under 35 USC § 103(a) and claims 11-12, 31, and 33 were rejected under 35 USC § 102(e). These rejections are fully traversed below.

Claims 1, 2, 6, 8, 13, 18-20 and 31 have been amended to further clarify the subject matter regarded as the invention. In addition, new claims 33-36 have been added. Claims 1-27 and 31-36 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

The 35 U.S.C. § 112, First Paragraph Rejection

Claims 13-27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action has once again alleged that former amendments to claim 13 are not support by the specification as required by the written description requirement and states “[a]s understood from applicant’s original disclosure, the system only identifies whether the domain name is actually registered or not registered (steps 910-912 in applicant’s Fig. 9). There are no steps of “identifying identical names” or “identifying variants of the name.” Applicant respectfully disagrees for the reasons, among others, discussed below.

While claim 13 was previously amended to recite “said searching (b) identifies one or more registrations of domain names that are **identical** to the name to be monitored, and ... said searching (b) identifies one or more registrations of domain names that are **variants** of the name to be monitored” (emphasis added), such limitations are disclosed in the Specification, and Applicant has, on several occasions, provided specific citations in the Specification to support the amendments.

MPEP § 2163.06 states: “information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” Additionally, MPEP § 2163.07 states that mere “rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible.”

As Applicant has previously cited, the original Specification, on page 22, lines 4-15 provides support for the amendment, which states:

For example, the monitoring could be for U.S. variations of the requestor's domain name or watching of international registrations for the requestor's domain name. The domain monitoring server 852 stores the request in the monitoring database 856. Thereafter, periodically, the domain monitoring server 852 retrieves the domain names to be monitored from the monitoring database 856. For each of the domain names to be monitored, the domain monitoring server 852 queries the registration database 864 for an indication of whether or not similar domain names have been registered. Typically, the domain name being monitored has already been registered by the requestor, and thus the monitoring of the domain names searches for new registrations of domain names that are substantially similar to the domain name being monitored.

Furthermore, page 22, lines 15-13 even provide for an example illustrating and supporting the amendment for "variants of the name to be monitored." The Specification provides:

For example, if the requestor had registered the domain name "amazon.com", the monitoring of the domain names could determine whether any amazon?.? are newly registered, where "?" represents one or more wildcard characters. Such monitoring could instead also search for more specific, and perhaps predetermined, domain names to limit the processing overhead. In any case, the monitoring for this example might flag new registrations for amazon.net, amazon.org, amazon.co.uk, amazon.org.uk, amazon.to, amazons.com, amazons.net, and amazons.org.

Additional support for the amendment may also be found on page 23, lines 18-20. Accordingly, it is respectfully submitted that claim 13 is fully supported by the original Specification in a manner that reasonably conveys to one skilled in the art that inventor has possession of the claimed invention. Likewise, dependent claim 14-27 are also completely supported in this regard.

Thus, it is respectfully requested that the Examiner withdraw the rejection of the claims 13-27 under 35 USC § 112, first paragraph.

The 35 U.S.C. § 103 Rejection

Claims 1-10 and 32 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schneider (USP 6,338,082) in view of Balijepalli (US Pub. 2004/0230566) among which Claim 1 is an independent claim. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.) § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Schneider except that "Schneider differs in that the search step is not recited as being performed periodically and automatically". The Office Action further contends that "Balijepalli teaches the concept of periodically and automatically performing a search for data on a network (paragraph 0008, last two lines) in order to return the most relevant and recent information to the user (paragraph 0004, last three lines)" and that it would be obvious to one having ordinary skill in the art at the time of the invention to "modify Schneider to perform periodic automatic searches and automatically deliver the results to the user in order to provide the most relevant and current information, as taught by Balijepalli." The Applicants respectfully disagree for the reasons, among others, set forth below.

The combination of Schneider and Balijepalli do not teach or suggest all the claim limitations. On page 3 of the Office Action, the Examiner references Fig. 3a of Schneider and its discussion at column 12, line 57 through column 13, line 25. At block 314 of Fig. 3a, a determination of whether a domain name is available is made. If the domain name is already registered, then it is not available and a record from the WHOIS database is displayed. First of all, it should be noted that the processing illustrated in Fig. 3a is performed on user request after a user input has been provided. In contrast, claim 1 is periodically and automatically performed to provide monitoring

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function to identify domain name registrations that match the name being monitored. The processing in Fig. 3a of Schneider does not perform a monitoring process. Nor is the processing in Fig. 3a of Schneider periodically and automatically performed.

The Office Action cites Balijepalli to overcome the serious deficiencies of Schneider. Balijepalli describes a web-based customized information retrieval and delivery method. Initially, Applicant submits that there is no reasonable expectation of success that the alleged combination of Schneider and Balijepalli would result in the claimed invention. Balijepalli is searching for "information corresponding to items contains in a user search list from two or more information sources on the World Wide Web (WWW)" (see abstract). Claim 1 is instead searching for domain name registrations. One of ordinary skill in the art would not believe it reasonable to combine Schneider with Balijepalli as proposed by the Office Action. Moreover, claim 1 has been amended to recited use of a domain space and variations while monitoring for domain name registrations. These additional features of claim 1 further patentably distinguish claim 1 from Schneider with Balijepalli.

Based on the foregoing, it is submitted that claim 1 is patentably distinct from Schneider and Balijepalli. In addition, it is submitted that claims 2-10 and 32 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider.

Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 1-10 and 32 under 35 USC § 103(a).

The 35 U.S.C. § 102 Rejection

Claims 11, 12, 31, and 33 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Schneider. This rejection is respectfully traversed. Claim 11 is an independent claim.

According to the M.P.E.P. § 2131, a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Specifically, the Office Action states that the “displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.” Applicant respectfully disagrees for the reason, among others, discussed below.

Claim 11 provides for “sending warning messages to registrants of the identified one or more registrations.” (emphasis added). Here, it is the offending registrant that is being sent a warning message. That is, the warning message is sent to the registrant of a domain name identified by searching a database of domain name registrations.

Schneider, at best, teaches merely notifying a requestor that a domain name is not available. Indeed, page 5 of the Office Action which states “Step (318) illustrates the return to the requestor of a displayed record of a domain name which such domain name is identified in the WHOIS database system. The displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.” Thus, the alleged “warning message” is thus necessarily provided to the requestor. In contrast, claim 11 is sending warning messages to registrants associated with the one or more registrations of domain names that have been identified, and not to the requestor who is monitoring availability of a name. Accordingly, Schneider fails to teach or suggest “sending warning messages to registrants of the identified one or more registrations” as claimed in Claim 11. Hence, it is submitted that claim 11 is patentably distinct from Schneider.

Based on the foregoing, it is submitted that claim 11 is patentably distinct from Schneider. In addition, it is submitted that claims 12, 31, and 33 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider.

Thus, it is respectfully requested that the Examiner withdraw the rejection of the claims 11, 12, 31, and 33 under 35 USC § 102(e).

Conclusion

It is believed that above-identified patent application into condition for allowance. Early favorable consideration of this Response is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-0388 (Order No. RLC1G000).

Respectfully submitted,

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